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EXAMINER

LUGO, CARLOS

ART UNIT PAPER NUMBER

3676

DATE MAILED: 09/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/753,093

Applicant(s)

LEI, JONATHAN L.

Examiner

Carlos Lugo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 84-104 is/are pending in the application.
- 4a) Of the above claim(s) 93-101 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 84-92 and 102-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to applicant's RCE filed on June 14, 2004.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 84-92 and 102-104, drawn to a self-contained business transaction capsule, classified in class 705, subclass 27.
 - II. Claims 93-101, drawn to a wireless electronic device, classified in class 455, subclass 90.1.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions in Groups I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, another materially different apparatus such a regular computer can practice the process, the self-contained business transaction capsule.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Mark Kendrick on August 26, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 84-92 and 102-104. Applicant in replying to this Office action must make

affirmation of this election. Claims 93-101 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "data" and "logics in form of executable code" claimed must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. **Claims 84-89 and 102-104 are rejected** under 35 U.S.C. 102(b) as being anticipated by Amazon.com (Amazon).

Regarding claims 84 and 102, Amazon discloses a self-contained business transaction capsule (a software to install in a Palm system, Page 1).

The capsule comprises:

A) Data regarding transaction products and services (all the product data, prices, etc., that will appear when a user search and data regarding the checkout when the user wants to buy).

B) Data regarding transaction participants (all the customer and seller data, etc).

C) Logic, in the form of executable code, enabling interaction between the transaction participants and the self-contained business transaction capsule (the logic or reasoning between Amazon and the user).

D) Logic, in the form of executable code, enabling modification of the wireless transaction (change in the transaction, billing or shopping search, etc).

E) Logic, in the form of executable code, regarding the wireless transaction and enabling transfer of the self-contained business transaction capsule from a

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wireless electronics device to other transaction participants (a person can downloaded the software to any palm device just by following the instructions).

As to claims 85 and 103, Amazon discloses that the capsule further includes:

- a) Logic, in the form of executable code, enabling copying of the self-contained business transaction capsule to other transaction participants (different users can downloaded the software to any palm device or cellular just by following the instructions in the Amazon web site).

As to claims 86 and 87, Amazon discloses that the capsule further includes:

- a) Logic, in the form of executable code, to access functionality with other wireless devices utilizing a peer-to-peer topology for data transmission (any amount of users can access the Amazon web site at the same time and download the capsule or software to their palm devices in a "peer to peer" topology between the web site and the different users).

As to claims 88,89 and 104, Amazon discloses that the capsule further includes:

- a) Logic, in the form of executable code, to access functionality in a remote mobile commerce system (the web site itself) for order processing, payment processing, or messaging utilizing a client-server topology for data transmission.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) The invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

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by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. **Claims 84-92 and 102-104 are rejected** under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,512,919 to Ogasawara (Ogasawara '919).

Regarding claims 84 and 102, Ogasawara discloses a self-contained business transaction capsule (the software downloaded to the cell phone, Col. 3 Lines 4-13).

The capsule comprises:

- A) Data regarding transaction products and services (Col. 5 Lines 49-59).
- B) Data regarding transaction participants (all the customer and seller data, etc).
- C) Logic, in the form of executable code, enabling interaction between the transaction participants and the self-contained business transaction capsule (the logic or reasoning between store server and the user).
- D) Logic, in the form of executable code, enabling modification of the wireless transaction (change in the transaction, billing or shopping search, etc).
- E) Logic, in the form of executable code, regarding the wireless transaction and enabling transfer of the self-contained business transaction capsule from a

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wireless electronics device to other transaction participants (a person can downloaded the software to any cellular device just by following the instructions).

As to claims 85 and 103, Ogasawara discloses that the capsule further includes:

- a) Logic, in the form of executable code, enabling copying of the self-contained business transaction capsule to other transaction participants (different users can download the software to any cellular at he same time, Col. 6 Lines 5-12).

As to claims 86 and 87, Ogasawara discloses that the capsule further includes:

- a) Logic, in the form of executable code, to access functionality with other wireless devices utilizing a peer-to-peer topology for data transmission (any amount of users can download the software at the same time and download the capsule or software to their phones in a "peer to peer" topology between the store server and the different users, Col. 6 Lines 5-12).

As to claims 88,89 and 104, Ogasawara discloses that the capsule further includes:

- a) Logic, in the form of executable code, to access functionality in a remote mobile commerce system (the store itself) for order processing, payment processing, or messaging utilizing a client-server topology for data transmission.

As to claim 90-92, Ogasawara '919 discloses that the capsule is broadcasted to the portable electronic device by at least one of a radio wave, a TV signal, a cellular telephony signal, a satellite signal and an infrared signal (Col. 5 Lines 1-9).

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10. Claims 84-89 and 102-104 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,385,591 to Mankoff.

Regarding claims 84 and 102, Mankoff discloses a self-contained business transaction capsule (the virtual coupon downloaded).

The capsule comprises:

- A) Data regarding transaction products and services (Figure 3).
- B) Data regarding transaction participants (customer data).
- C) Logic, in the form of executable code, enabling interaction between the transaction participants and the self-contained business transaction capsule (the logic or reasoning between web site and the user).
- D) Logic, in the form of executable code, enabling modification of the wireless transaction (transfer the virtual coupon in a retail establishment, Abstract Lines 17-22).
- E) Logic, in the form of executable code, regarding the wireless transaction and enabling transfer of the self-contained business transaction capsule from a wireless electronics device to other transaction participants (a person can download the software to any palm device just by following the instructions).

As to claims 85 and 103, Mankoff discloses that the capsule further includes:

- a) Logic, in the form of executable code, enabling copying of the self-contained business transaction capsule to other transaction participants (different users can download the software to any palm device).

As to claims 86 and 87, Mankoff discloses that the capsule further includes:

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a) Logic, in the form of executable code, to access functionality with other wireless devices utilizing a peer-to-peer topology for data transmission (any amount of users can access the web site at the same time and download the capsule or software to their palm devices in a "peer to peer" topology between the web site and the different users).

As to claims 88,89 and 104, Mankoff discloses that the capsule further includes:

a) Logic, in the form of executable code, to access functionality in a remote mobile commerce system (the web site itself) for order processing, payment processing, or messaging utilizing a client-server topology for data transmission.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 90-92 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Amazon.com (Amazon) in view of Bluetooth.

Amazon fails to disclose the use of short-range radio waves. Amazon discloses that any wireless portable electronic device can be used (cellular, palm, etc).

Bluetooth teaches that is known in the art to have a portable electronic device of short-range.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Bluetooth wireless networking protocol, as taught by Bluetooth, into a portable electronic device as described by Amazon, in order to have a better communication.

13. **Claims 90-92 are rejected** under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,385,591 to Mankoff in view of Bluetooth.

Mankoff fails to disclose the use of short-range radio waves.

Bluetooth teaches that is known in the art to have a portable electronic device of short-range.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a Bluetooth wireless networking protocol, as taught by Bluetooth, into a portable electronic device as described by Mankoff, in order to have a better communication.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lugo whose telephone number is 703-305-9747. The examiner can normally be reached on 9-6pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

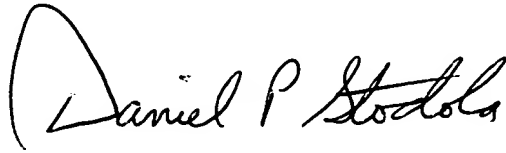
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

C.L.

Carlos Lugo
AU 3676

August 31, 2004.

A handwritten signature in black ink, reading "Daniel P. Stodola". The signature is fluid and cursive, with a large initial 'D'.

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600